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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,320	02/18/2004	Mark W. Jolley	82421	9435

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CHICAGO, IL 60603-3406

EXAMINER

BASINGER, SHERMAN D

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/781,320	JOLLEY, MARK W.	
	Examiner	Art Unit	
	Sherman D. Basinger	3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 and 7-22 is/are rejected.
- 7) ☒ Claim(s) 3 and 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 6 is objected to because of the following informalities: in claim 6 "the gasket" has no clear antecedent. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 depends from canceled claim 13.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 7, 9, 14 and 16-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirsch.

Hirsch discloses a method of manufacturing a board, the method comprising
providing upper and lower sheets of material 54,

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inserting the upper and lower sheets of material into an interior of a first mold cavity 44,46;

forming the upper and lower sheets of material to the interior of the first mold cavity to form a shell having a single hollow interior (see figures 6 and 7);

filling the entire shell with an expandable material (see column 3, lines 33-39); and

preventing the shell from substantially deforming during filling with the expandable material by inserting the shell into a second mold cavity (column 4, lines 19-25) having a shape substantially conforming to the shell, the second mold cavity being different from the first mold cavity.

With regard to claim 7, see column 3, line 20.

With regard to claim 9, see column 3, line 42.

With regard to claim 14, note column 3, lines 7 and 8.

With regard to claim 16, see column 2, lines 29-30.

For claim 17, Hirsch discloses a method of manufacturing an apparatus, the method comprising means (see figure 5) for forming at least two sheets of material 54 to the interior of a first mold cavity to form a shell having a single hollow interior; and means (figure 6a) for filling the entire shell with an expandable material in a second mold cavity (see column 4, lines 19-25) having a shape substantially conforming to the shell, the second mold cavity preventing the shell from substantially deforming during filling with the expandable material.

With regard to claim 18 Hirsch discloses a floatable surfboard.

For claim 19, Hirsch discloses a board in figure 1 comprising a generally planar polymer (polycarbonate) shell having first and second sheets of material 54, the first and second sheets of material each having a perimeter and being spaced apart between the perimeters as is shown in figure 6a, 6b and 6c, the perimeters of the first and second sheets of material being bonded together to form periphery edges of the board free from attachment to anything other than the shell itself as is shown in figure 6a; and a core of a material shown in figure 7 different than the material of the first and second sheets, the core substantially filling the interior of the shell between the periphery edges and inherently having residual compressive stresses providing structural rigidity to the shell.

For claim 20 see column 5, lines 13 and 14.

The graphics of claim 21 is the section of the stringer 21 contacting the interior of the shell and which is between the core and the interior of the shell.

For claim 22, Hirsch discloses a method of manufacturing a board, the method comprising providing upper and lower sheets 54 of a generally rigid polymer material (polycarbonate); inserting the upper and lower sheets of material into an interior of a mold cavity (see figure 5); forming the upper and lower sheets of material to the interior of the mold cavity to

form a shell having a single hollow interior (see figure 6a);
filling the entire shell with a expandable material to form a generally rigid inner core
(see column 3, lines 33-39); and
preventing the shell from substantially deforming during filling with the expandable
material using a mold cavity having a shape substantially conforming to the shell (see
figure 7).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 4, 5, 8, 10, 11, 12 and 15 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Hirsch in view of Teraoka et al.

Hirsch does not disclose wherein the step of inserting the upper and lower sheets into
an interior of a first mold cavity includes

clamping a perimeter of the upper sheet of material and a perimeter of the lower
sheet of material; including the step of blowing fluid between the upper and lower

sheets of material for spacing at least a portion of the upper and lower sheets of
material apart; wherein the step of forcing the upper and lower sheets of material

against interior walls of the mold cavity includes at least one of drawing the upper and
lower sheets of material against the interior walls with a vacuum and forcing the upper

and

lower sheets of material against the interior walls with a pressure force between the sheets; wherein the step of filling the shell with the expandable material comprises the steps of forming an aperture in the shell, inserting a filling device through the aperture; and passing the expandable material through the filling device and into the shell; including the step of withdrawing the filling device from within the shell while the shell is being filled with the expandable material; including the step of heating the mold cavity to allow the expandable material to at least partially bond to the shell; and including the step of applying graphics to at least one of the first and second sheets of material prior to the step of inserting the upper and lower sheets of material into an interior of a mold cavity.

Teraoka et al discloses that the step of inserting the upper and lower sheets 17 into an interior of a first mold cavity (figure 11) including clamping a perimeter of the upper sheet of material and a perimeter of the lower sheet of material as is shown in figure 14 by the clamping of the ends of the sheet by the mold; the step of blowing fluid between the upper and lower sheets of material for spacing at least a portion of the upper and lower sheets of material apart (column 9, lines 31-34); that the step of forcing the upper and lower sheets of material against interior walls of the mold cavity includes at least one of drawing the upper and

lower sheets of material against the interior walls with a vacuum and forcing the upper and lower sheets of material against the interior walls with a pressure force between the sheets (column 9, lines 16-20 and lines 31-34); that the step of filling the shell with the expandable material comprises the steps of forming an aperture in the shell, inserting a filling device through the aperture and passing the expandable material through the filling device and into the shell (column 9, lines 50-end)

In view of the teachings of Teraoka et al it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to insert the upper and lower sheets 54 of Hirsch into an interior of a first mold cavity (figure 7) and include clamping a perimeter of the upper sheet of material and a perimeter of the lower sheet of material by clamping the ends of the sheet by the mold; to blow fluid between the upper and lower sheets of material for spacing at least a portion of the upper and lower sheets of material apart; to force the upper and lower sheets of material against interior walls of the mold cavity by drawing the upper and lower sheets of material against the interior walls with a vacuum and forcing the upper and lower sheets of material against the interior walls with a pressure force between the sheets; and to fill the shell with the expandable material by forming an aperture in the shell, inserting a filling device through the aperture and passing the expandable material through the filling device and into the shell.

Motivation to do the above is to use easy and well know ways of forming the shell, filling the shell with foam and having it cure.

It would also have been obvious to one having ordinary skill in the art to withdraw the filling device from within the shell while the shell is being filled with expandable material so that the material will fill in the space where the filling device was located, and apply graphics to at least one of the first and second sheets of material prior to the step of inserting the upper and lower sheets of material into an interior of a mold cavity to apply a Trademark or to give safety directions for the use of the surfboard. Applying graphics before molding the shell avoids the cost of having to apply graphics after the shell is molded to its preferred shape. Applying graphics to a flat sheet is easier than applying graphics to a curved surface.

Allowable Subject Matter

8. Claims 3 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

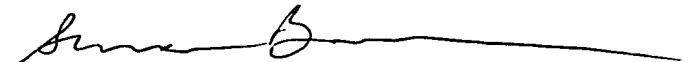
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherman D. Basinger whose telephone number is 571-

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272-6679. The examiner can normally be reached on Monday through Friday, 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sherman D. Basinger
Primary Examiner
Art Unit 3617

1/30/06